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10/768,023	02/02/2004	Nozomi Sawada	246853US-2 DIV	7240
22850	7590	03/13/2009		
OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			EXAMINER KAU, STEVEN Y	
			ART UNIT	PAPER NUMBER
			2625	
			NOTIFICATION DATE	DELIVERY MODE
			03/13/2009	ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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<b>Office Action Summary</b>	<b>Application No.</b> 10/768,023	<b>Applicant(s)</b> SAWADA, NOZOMI	
	<b>Examiner</b> STEVEN KAU	<b>Art Unit</b> 2625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 20 November 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-6, 10-13, 15 and 19-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6, 10-13, 15 and 19-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### *Response to Amendment*

1. Applicant's amendment was received on 11/20/2008, and has been entered and made of record. Currently, claims 7-9, 14 and 16-18 have been cancelled, and claims 1-6, 10-13, 15, and 19-23 are pending for further examination in this Action.

### *Response to Remark/Arguments*

2. Applicant's arguments with respect to claims 1-6, 10-13, 15, and 19-23 have been fully considered but are moot in view of the new ground(s) of rejection.

### *Claim Rejections - 35 USC § 103*

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-6, 10, 12, 13, 15, and 19-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kakutani (US 6,817,794) in view of Ogura et al (US 5,608,494).

Regarding claim 1.

Kakutani discloses an image forming apparatus (**i.e. the printer of Figs. 1, 2, and 4, etc., col 4, lines 51-57**) comprising: a storage unit (**i.e. a nonvolatile memory**

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**for storing the alternate table, col 6, lines 50-54); and a processor (i.e. Kakutani discloses multiple embodiments which a printer having a printer drive unit performs printing processes of Figs. 3, 5 and 11, etc., and instruction from a host computer, Fig. 2, col 5, lines 45-50; thus, a printer must have a processor to perform such multiple processes) configured to determine (i.e. print job) corresponding to a print instruction (i.e. analyzing/judging print job data including print instruction from the host, col 5, lines 45-59) and to execute the print instruction by automatically changing a size of a recording medium to be used as specified by the print instruction to the size of the substitute recording by accessing the storage unit to determine (i.e. steps of S104 and S105 of Figs 3 and 5 disclose an automatically change size of a recording medium, col 6, line 55 to col 7, line 19), which substitute recording medium corresponds to the size of the recording medium specified by the print instruction (i.e. size and type of substitute recording medium is registered corresponding to the recording medium specified by the host computer, col 5, lines 4-27), when the size of the recording medium specified by the print instruction is not available (col 5, lines 4-27);**

Kakutani does not disclose storing a plurality of user identifiers, and for each user identifier there is also stored a corresponding recording medium size and a size of a substitute recording medium, and for the user identifier corresponding to the print instruction.

However, Kakutani discloses an alternate table set 200 in Fig. 9, in which each 20-1, 20-2, ... 20-n is corresponded to each of a plurality of host devices in the network.

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For example, the paper size and paper type of host device 1-1 are registered in the alternate table 20-1, and the paper size and paper type of host device 1-2 are registered in the alternate table 20-2, and so on. See col 9, lines 4-20.

The above described differences between the claims are obvious variations of each other.

In addition, in the same field of endeavor, Ogura teaches an embodiment in that a memory card is used to store operator's ID codes ,i.e. ID1, ID2, and ID3, etc., and counting number of sheets copied and size of the paper corresponding to ID codes as shown in Figs. 6 and 8, and col 6, lines 20-34.

Thus, having an image forming apparatus of Kakutani' 794 reference and then given the well-established teaching of Kakutani' 794 reference, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the image forming apparatus of Kakutani' 794 reference such that storing a plurality of users instead of a plurality of hose devices, to achieve for each user identifier there is also stored a corresponding recording medium size and a size of a substitute recording medium, and for the user identifier corresponding to the print instruction as taught by Ogura; since doing so would increase the versatility of the image forming apparatus and further the services provided could easily be established for one another with predictable results.

Regarding claim 3, in accordance with claim 1.

Kakutani discloses wherein the storage, unit is configured to store the information size of the substitute recording medium in response to an external setting instruction

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from outside (**i.e. size and type of substitute recording medium is registered corresponding to the recording medium specified by the host computer, col 5, lines 4-27**).

Regarding claim 4, in accordance with claim 3.

Kakutani discloses a notifying device configured to notify to the outside when the size of the recording medium specified by the print instruction is not available or when the size of the substitute recording medium is not stored in the storage unit, together with information indicating an available size of the recording medium, so as to request a selection of a recording medium size to use to execute the print instruction (**i.e. when there is an error is so judged, i.e. paper size and paper type specified are not registered, operator or the host device is notified, col 5, lines 1-3, and in responses to the outside, error processing unit 19 of Fig. 2 notifies tray selection unit 14 and the printing processing is continued, col 6, lines 21-44, and col 10, also see Figs. 18A-18B, col 10, line 56 to col 11, line 10**).

Regarding claim 5, in accordance with claim 1.

Kakutani discloses a setting device (**i.e. host devices of Figs 1, 2, and 4 and so on**) configured to set and store the size of the substitute recording medium in the storage unit (**i.e. paper size and paper type of substitute recording medium are specified by the hose device and configured into the alternate table of Fig. 9, col 9, lines 4-20**).

Regarding claim 6, in accordance with claim 1.

Kakutani discloses wherein said of a table storage device (**i.e. alternate table**) stores the plurality of (**host device**) identifiers, the corresponding recording medium size, and the corresponding size of the substitute recording medium in a table (**i.e. paper size and paper type of substitute recording medium are specified by the hose device and configured into alternate table of Fig. 9, col 9, lines 4-20**).

Kakutani does not disclose said of a table storage device stores the plurality of user identifiers.

However, base on the same rational discussed in Claim 1 rejection above, Kakutani discloses an alternate table set 200 in Fig. 9, in which each 20-1, 20-2, ... 20-n is corresponded to each of a plurality of host devices in the network. For example, the paper size and paper type of host device 1-1 are registered in the alternate table 20-1, and the paper size and paper type of host device 1-2 are registered in the alternate table 20-2, and so on. See col 9, lines 4-20.

The above described differences between the claims are obvious variations of each other.

Thus, having an image forming apparatus of Kakutani' 794 reference and then given the well-established teaching of Kakutani' 794 reference, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the image forming apparatus of Kakutani' 794 reference such that storing a plurality of users instead of a plurality of hose devices, to achieve a table storage device stores the plurality of user identifiers; since doing so would increase the versatility of the

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image forming apparatus and further the services provided could easily be established for one another with predictable results.

Regarding claim 10.

Claim 10 is directed to an image forming method claim which substantially corresponds to operation of the device in claim 1, with method steps directly corresponding to the function of device elements in claim 1. Thus, claim 10 is rejected as set forth above for claim 1.

Regarding claim 12, in accordance with claim 10.

Claim 12 is directed to an image forming method claim which substantially corresponds to operation of the device in claim 3, with method steps directly corresponding to the function of device elements in claim 3. Thus, claim 12 is rejected as set forth above for claim 3.

Regarding claim 13, in accordance with claim 12.

Claim 13 is directed to an image forming method claim which substantially corresponds to operation of the device in claim 4, with method steps directly corresponding to the function of device elements in claim 4. Thus, claim 13 is rejected as set forth above for claim 4.

Regarding claim 15, in accordance with claim 10.

Claim 15 is directed to an image forming method claim which substantially corresponds to operation of the device in claim 6, with method steps directly corresponding to the function of device elements in claim 6. Thus, claim 15 is rejected as set forth above for claim 6.

Regarding claim 19.

Claim 19 is directed to a computer-readable storage medium claim which substantially corresponds to operation of the device in claim 1, with processing steps directly corresponding to the function of device elements in claim 1. Thus, claim 19 is rejected as set forth above for claim 1.

Regarding claim 20.

Claim 20 is directed to a computer-readable storage medium claim which substantially corresponds to operation of the device in claim 1, with processing steps directly corresponding to the function of device elements in claim 1. Thus, claim 20 is rejected as set forth above for claim 1.

Regarding claim 21.

Kakutani discloses wherein the computer (**i.e. a CPU or a central process unit**) is one of a computer within a host unit (**i.e. host devices of Figs. 1, 2, and 10 and etc.**) which outputs the print instruction with respect to an image forming apparatus and a computer within the image forming apparatus which prints the-information on the recording medium (**i.e. host device outputs print data, which includes instruction, i.e. paper size and paper type, to printer of Figs. 1, 2, and 10, etc., the processor having a printer drive unit performs printing process, Figs. 1, 2, and 10, etc., and col 9, lines 21-57**).

Regarding claim 22.

Claim 22 is directed to an image forming device claim which substantially corresponds to operation of the device in claim 1, with function elements directly

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corresponding to the function of device elements in claim 1. Thus, claim 22 is rejected as set forth above for claim 1.

Regarding claim 23.

Claim 23 is directed to a computer-readable storage medium claim which substantially corresponds to operation of the device in claim 1, with processing steps directly corresponding to the function of device elements in claim 1. Thus, claim 23 is rejected as set forth above for claim 1.

5. Claims 2 & 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kakutani (US 6,817,794) in view of Ogura et al (US 5,608,494) as applied to claims 1 and 10 above, and further in view of Yoshino et al (US 4,944,031).

Regarding claim 2, in accordance with claim 1.

Kakutani discloses wherein said storage unit is configured to store, in correspondence with at least one of the **(host device) identifiers (i.e. storage unit, i.e. paper tray, is configure to store at least one of hose device identifier, i.e. 1-1, 1-2, ..1-n, col 9,lines 3-20 and Fig. 9).**

Kakutani dose not disclose storage unit is configured to store in correspondence with at least one of the user identifiers and information specifying whether or not a zoom is required when printing information, and/or information specifying a printing position on the recording medium.

However, Kakutani discloses an alternate table set 200 in Fig. 9, in which each 20-1, 20-2, ... 20-n is corresponded to each of a plurality of host devices in the network.

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For example, the paper size and paper type of host device 1-1 are registered in the alternate table 20-1, and the paper size and paper type of host device 1-2 are registered in the alternate table 20-2, and so on. See col 9, lines 4-20; and the above described differences between the claims are obvious variations of each other; and

Yoshino teaches wherein said setting information includes whether or not a zoom is required when printing information, and/or a printing position on the recording medium **(i.e. magnification such enlargement and reduction ratio are used, col 8, lines 24-68, and direction identification marks for printing positions, col 5, line 44 to col 6, line 13).**

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Kakutani' 794 such that storing a plurality of users instead of a plurality of host devices and to include setting information includes whether or not a zoom is required when printing information, and/or a printing position on the recording medium as taught by Yoshino to allow user to select desired image parameter settings to produce hardcopies with satisfactory image quality.

Regarding claim 11, in accordance with claim 10.

Claim 11 is directed to an image forming method claim which substantially corresponds to operation of the device in claim 2, with method steps directly corresponding to the function of device elements in claim 2. Thus, claim 11 is rejected as set forth above for claim 2.

***Conclusion***

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven Kau whose telephone number is 571-270-1120 and fax number is 571-270-2120. The examiner can normally be reached on Monday to Friday, from 8:30 am -5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Moore can be reached on 571-272-7437. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Steven Kau/  
Examiner, Art Unit 2625  
3/9/2009

/David K Moore/  
Supervisory Patent Examiner, Art Unit 2625